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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,708	09/21/1999	MICHAEL L. GOUGH	NEO1P018	3709

7590 07/11/2005  
PERKINS COIE LLP  
101 JEFFERSON DRIVE  
MENLO PARK, CA 94025-1114

EXAMINER
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VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/400,708

Applicant(s)

GOUGH, MICHAEL L.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 1-3,5-8,11-22 are pending. Claims 4,9 and 10 are canceled. Claims 1-3,5-8,11-22 have been renumbered as 1-19.

***Response to Amendment***

2. Applicant's amendment with respect to claims 1,15 and 16 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1,15 and 16 have been amended. Therefore the Final action is appropriate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bendinelli et al [Bendinelli, 6,061,719].

5. As per claim 1, Bendinelli discloses a method for executing an application program associated with an electronic message, comprising:

after an electronic message is received over a network is selected by  
automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user, wherein the application

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program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message [Bendinelli, automatically retrieve information over a computer network, receiving at least in portion of signal, displayed retrieved information to viewer who is permitted to select information, col 7 lines 43-60; col 10 lines 24-40];

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof [Bendinelli, the programming (i.e.: automatically) corresponds to an advertisement (i.e.: electronic message) which displays the context, col 3 lines 12-35].

6. Claims 12 and 17 contain the similar limitations set forth of method claim 1. Therefore, claims 12,17 are rejected for the similar rationale set forth in claim 1.

7. As per claim 2, Bendinelli discloses the electronic message is opened by the user by clicking on an identifier of the electronic message in an electronic mail browser [Bendinelli, a viewer selects display of web page from a URL, col 5 lines 33-56].

8. As per claims 3,11,14 Bendinelli discloses the application program includes an applet as inherent feature of Web based applications.

9. As per claim 4, Bendinelli discloses the execution of the application program includes a functionality based on the text included with the electronic message as inherent feature of Web based applications.

10. As per claim 5, Bendinelli discloses the execution of the application program includes streaming video as inherent feature of Web based applications.

11. As per claim 6, Bendinelli discloses the execution of the application program includes outputting an advertisement [Bendinelli, advertisement, col 3 lines 13-35].

12. As per claims 7,13 Bendinelli discloses at least one code segment resides, at least in part, in a browser software [Bendinell, browser program, col 5 lines 7-32].

13. As per claim 8, Bendinelli discloses the execution of the application program includes the ability to send a new electronic message over the network [Bendinelli, different types of display, variety of web sites, col 5 lines 33-56].

14. As per claim 10, Bendinelli discloses the application program includes markup language which calls an object-oriented computer language as a design choice of other suitable network access software [Bendinelli, col 5 lines 7-32].

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15. As per claims 9,15,16,18,19 Bendinelli discloses the application develops at least one of pictorial, graphic, animated, video and audio display distributed as inherent feature of Web based applications.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
**Patent Examiner**  
**Art Unit 2142**

